

Interview

The courtesy of the Examiner extending an interview on February 25, 1997 is appreciated.

At the interview, claims 1 and 26, as amended in this Amendment, were provided to the Examiner. Also, a summary of the arguments as set forth below was presented to the Examiner together with a copy of the Fahlman reference. The Examiner agreed to allow independent claims 1 and 26 and the remaining dependent claims provided that an Amendment was presented specifying, in written form, why the claims are patentable.

Response to Rejections

First Rejection

Claims 1, 10, 13, and 14 were rejected under 35 U.S.C. §103 as being unpatentable over Tanaka in view of Fujii and Fahlman (U.S. Patent 2,003,587). This rejection is traversed. The substance of the rejection is found in the Office Action on pages 2 and 3.

The combination of references does not establish a prima facie case of obviousness for the subject matter as a whole. Even combining the references, as asserted in the Office Action, does not provide the structure in the context claimed. Additionally, the added new reference to Fahlman actually teaches away from solving the problem that the inventor has solved in the context claimed.

The Office Action correctly identifies that the references to Tanaka in view of Fujii do not disclose the electrical insulating coating claimed. In the Office action, Fahlman is relied on to show this feature.

Before pointing out how the claims specifically distinguish over the combination of references, a brief description of the new reference to Fahlman is set forth as follows:

This reference discloses a thin coated layer of heat and an electrical insulating material between the rotor and cast conductor bars. This material can be applied by spraying or dipping. The purpose of this coating is to protect the conductive material (e.g. aluminum) from "cold shock" when the aluminum is cast into the slots. What Fahlman teaches is that the core is heated to about 1,000°F before the molten aluminum is poured. This heated core, which also has the insulation, allows the heat from the heated core to be present when the aluminum is poured so that the aluminum is not "cold shocked", see for example, page 2 column 1, lines 51-61 of the reference. Additionally, the core with its lamination is within 50°F from the temperature of the cast aluminum. See for example, page 2, right column, lines 20-23.

In the present claimed device, the purpose of the electrical insulation is to prevent the heat from the casting process effecting the laminations including the intervening insulation from

the adverse effects of the heating. To accomplish this, the present claimed device provides an electrical insulating coating that is thermally resistant to the passage of heat. This means that when the conductor is cast, the electrical insulating coating prevents the heat from the conducting process from effecting the core laminations.

The suggestions in Fahlman actually teaches away from the structure claimed. In Fahlman there was no recognition of any problem of heat affecting the core itself. In fact, Fahlman must heat the core during the casting operation and thus the heating of the core can effect the core itself. Fahlman did not recognize this problem and offers no solution to this heat affecting problem. It is the present inventor who recognized the problem and solved the problem of the effect of the dicasting process on the core laminations. Certainly following the teachings of Fahlman would destroy the very purpose of the problem that the applicant solved.

It appears that the Office Action has only picked and chosen from the Fahlman reference only so much of it (the insulation) that will support the position of obviousness. The Office Action has not considered and has excluded the other steps necessary (the heating of the core in Fahlman) necessary to the full appreciation of what the reference fairly suggests to one of ordinary skill in the art. See In Re Wesslau, 353 F.2d 238, 147 USPQ 391, 393 (CCPA 1951) which states as follows:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

Additionally, while the Office Action relies on "design choice", the applicants structure performs a function that is substantially different from the prior art and is not a "design choice". As set forth in the case of In re Chu, 36 USPQ 2d 1089, 1095 (Fed. Cir. 1995) citing In re Gal, 25 USPQ 2d 1076 (Fed. Cir. 1992) "finding of obvious design choice precluded when the claim structure and the function it performs are different from the prior art."

In summary none of the reference alone or in combination teach or suggest the structure and result of the structure in the context claimed.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of claims 1, 10, 13, and 14 under 35 U.S.C. §103.

Second Rejection

Claims 11 and 22-25 were rejected under 37 USC §103 as being unpatentable over Tanaka in view of Fujii and Fahlman. This

rejection is traversed. The reasons for the rejection appear on page 4 of the Office Action.

The comments set forth in the Response to the First Rejection are incorporated herein. The particular claims rejected had specifics of the ceramic material to achieve the result. That is the result is the heat protection of the core and to provide the necessary electrical insulation required in the combination.

In rejecting these claims, the Office Action asserts that the materials are known and that it would be an obvious matter of design choice to provide these materials. The Office Action relies on In Re Leshin, 125 USPQ 416 (CCPA 1960). This case is explained in MPEP §2144.07.

The facts in In re Leshin are completely different than the facts in this application. In In re Leshin there was factual evidence that the plastic material was known to those in the art. In the present application, no evidence has been supplied that the specific ceramic materials are known nor is there any evidence that these materials would be known for their particular properties in the particular environment. As set forth in the guidelines of MPEP §2144 to rely on case precedence, the facts must be the same. See MPEP §2144, right column, which states in part as follows:

LEGAL PRECEDENCE CAN PROVIDE THE RATIONAL SUPPORTING OBVIOUSNESS ONLY IF THE FACTS IN THE CASE ARE SUFFICIENTLY SIMILAR TO THOSE IN THE APPLICATION.

In addition, while the Office Action asserts that these materials are well-known, no evidence has been supplied. If the Patent Office is to repeat such a rejection, it is requested that art establishing these facts be supplied under the provisions of MPEP §2144.03.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of claims 11 and 22-25 under 35 U.S.C. §103.

Third Rejection

Claims 26-28 and 36-38 were rejected as being unpatentable over Tanaka in view of Fahlman. This rejection is traversed.

The combination of Tanaka in view of Fahlman does not teach the structure as claimed. For example, claim 26, which is the base claim, requires that the electrical insulating coating be resistant to the passage of heat. This is not suggested by the combination of references in particular, is not suggested from Fahlman as explained in Response to the first rejection supra. That explanation is being incorporated herein by reference.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of claims 26-28 and 36-38 on under 35 U.S.C. §103.

Fourth Rejection

Claims 29-35 and 39-43 were rejected under 35 U.S.C. §103 as being unpatentable over Tanaka in view of Fahlman. This rejection is traversed.

In explaining this rejection, the Office Action asserts that the materials were known and it would be an obvious design choice to select the material. The Office Action relies on the case of In re Leshin (cited above).

As explained above in response to the second rejection, Fahlman nor the doctrine set forth in In re Leshin suggests the specific combination as claimed.

As explained in the response to the second rejection and this rejection, the applicants claimed structure and the function it performs are different and not obvious from the prior art applied.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of claims 29-35 and 39-43 under 35 U.S.C. §103.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Elliot A. Goldberg at (703) 205-8000 in the Washington, D.C. area, to discuss these matters.

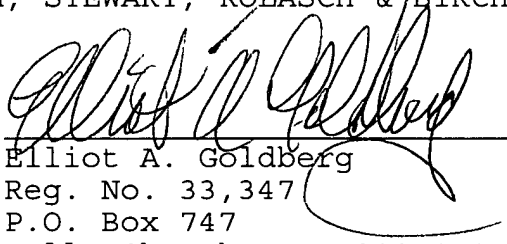
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Please charge any fees or credit any overpayments pursuant to
37 C.F.R. 1.16 and 37 C.F.R. 1.17 to Deposit Account No. 02-2448.

Respectfully submitted,

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